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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,860	04/16/2004	Michael S. Banik	01-468US2	8202
27774	7590	12/02/2004	EXAMINER	
MAYER, FORTKORT & WILLIAMS, PC 251 NORTH AVENUE WEST 2ND FLOOR WESTFIELD, NJ 07090			LACYK, JOHN P	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,860

Applicant(s)

BANIK, MICHAEL S.

Examiner

John P Lacyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13-17, 23-24, 41-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13-15 are directed to the intended use of the device and fail to provide any further structural limitations of the device. In claims 16-17, 23-24, 41-42 the sensing system is not connected in any way to the rest of the device.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 11-15, 20-22, 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al in view of Maseda.

Kaplan et al discloses the claimed device having a cuff placed around a body lumen that has an actuator to expand and/or contract to open or close the body lumen. Kaplan et al discloses the claimed device except for the use of an electroactive polymer as the actuator to expand or contract the cuff. Although Kaplan et al does state (column 2, line 66- column 3, line 4) that the actuator may vary widely and that it is only necessary that the actuator be able to receive power to open and close the body lumen by modulating a compressive or constraining force over the body lumen. Maseda discloses the use of

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electroactive polymers that are used in the body as actuators for medical devices to induce many movements including expansion and contraction. Maseda teaches (column 3, lines 50-64) that an electroactive polymer actuator can be used in any type of device. Therefore a modification of Kaplan et al to substitute the actuator with an electroactive polymer actuator, as taught by Maseda, would have been obvious since this would have been the mere substitution of one well known type of actuator used in the body to expand and/or contract for another.

5. Claims 2-10, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al and Maseda as applied to claims listed above, and further in view of Madden et al.

Madden et al discloses electroactive polymer actuators and teaches that it is well known to use polypyrrole as the polymer. Kaplan and Maseda, as discussed above, disclose the claimed device except for specifically using polypyrrole as the polymer. Therefore a modification of Kaplan and Maseda such that the polymer used is polypyrrole would have been obvious since it is well known to use such a polymer in an actuator as taught by Madden et al.

6. Claims 29-40, 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al, Maseda and Madden et al as applied to claims listed above, and further in view of Shahinpoor et al.

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As discussed above the references teach the claimed device except for use as a muscle patch adapted to be implanted adjacent a patient's heart. While this is considered to be merely directed to the intended use of the device, Shahinpoor et al discloses an actuator and artificial muscle using polymers as a sphincter-type or squeeze-type actuator used in medical appliances for incontinence and cardiac-assist devices (column 6, lines 29-31). Therefore to use such a device as taught in Kaplan et al, Maseda and Madden as a muscle patch to assist in cardiac functions would have been obvious in view of the teachings of Shahinpoor et al which shows that these types of devices are well known to be used in both applications in the body.

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 16-17, 23, 41-42 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 16-17, 23, 41-42 of prior U.S. Patent No. 6,749,556. This is a double patenting rejection.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


10. Claims 1-15, 18-22, 24-40 and 43-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, 18-22, 24-40 and 43-44 of U.S. Patent No. 6,749,556. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are the same except for the patented claims include a conductive polymer, however the elimination of an element and subsequent loss of its function is an obvious expedient if the remaining elements perform the same functions as before. Therefore the elimination of the conductive polymer would have been an obvious expedient and therefore the difference between the claims of the application and the claims of the patent lies in the fact that the patent claims include more elements and is thus more specific. Thus the invention of the patented claims are in effect a "species" of the "generic" invention of the pending claims and it has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the application are anticipated by the patented claims, they are not patentably distinct from the patented claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P Lacyk whose telephone number is 571-272-4728.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Lacyk
Primary Examiner
Art Unit 3736

J.P. Lacyk